

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed November 18, 2004. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has made a provisional, judicially created, obviousness-type double patenting rejection. As stated before, this application is in prosecution and claims are not yet allowed. If the present condition were to exist upon allowance of all claims, Applicants would favorably consider filing a terminal disclaimer.

Claims 16-20 have been rejected under 35 U.S.C. 102 as being anticipated by U.S. Patent No. 6,169,992, issued to Beall et al (hereinafter referred to as "Beall"). This ground of rejection is respectfully traversed.

The standard for a finding of anticipation is found in MPEP 2131 which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v.*

Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Beall does not anticipate claims 16-20, because it does not meet "each and every element as set forth in the claim[s]" as required by MPEP 2131.

Specifically, with regard to claim 16, Beall does not have: "means for modifying data within a data base"; "means for designing a service to modify said data within said data base"; and "means for storing said service within said data base for future use". Beall does not have any mention of modification of data within a data base. In making her rejection, the Examiner cites Beall, column 43, lines 48-46 (sic), and column 50, lines 9-16. These citations refer to modification of the "data base structure". There is no suggestion that any particular user of Beall can actually modify the data itself. Surely, the Examiner can distinguish between changing the structure of a data base (as in Beall) and changing the data itself. Any suggestion by the Examiner that the structure of a data base and the data of a data base are synonymous is clearly erroneous.

Beall shows no "means for designing a service to modify said data". Instead, the Examiner attempts to confuse the situation by suggesting that Fig. 27 through Fig. 31 is "an ordered sequence of steps". However, the claim requires that this ordered sequence of steps is created by the "designing means".

Applicants' have claimed a "designing means". The Examiner has not even attempted to show a "designing means".

The Examiner admits that Beall has no "storing means". Thus, missing at least these three apparent claim limitations, Beall cannot anticipate claim 16. The rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 17 depends from claim 16 and further requires "an inhibiting means". The Examiner fails to identify an inhibiting means in Beall because there is none. Instead, as if to add further confusion, the Examiner cites a "Cancel" button of Beall. Though the reference says nothing of the operation of this "Cancel" button, it does describe the actions of a human user.

The cited column 30, lines 6-7, states:

The user may cancel the operation by clicking on a cancel button 637. (Emphasis added)

To the extent that the Examiner reads the "inhibiting means" on a human being (i.e., the user), the rejection is defective, as a matter of law. The rejection of claim 17, and any claims depending therefrom, is respectfully traversed.

Claim 18 depends from claim 17 and further limits the connecting network. Because Beall does not anticipate claim 17 from which claim 18 depends, it cannot anticipate claim 18 with these further unique limitations. The rejection of claim 18 is respectfully traversed.

Claim 19 depends from claim 18 and further limits the claimed "data base management system" to a "commercial data base management system". In making her rejection, the Examiner cites column 3, lines 31-59, of Beall, which mentions a "data base management system" (see lines 31-32) and an alleged commercial product of CADIS, Inc. (see line 51) which is not a "data base management system". However, there is no "commercial data base management system" as claimed. The rejection of claim 19 is respectfully traversed.

Claim 20 depends from claim 19 and further limits the software architecture of the claimed user terminal. Confusingly, the Examiner cites Client Computer 4018 on Fig. 3, which says nothing of the software architecture. The rejection of claim 20 is respectfully traversed as based upon clearly erroneous findings of fact.

Claims 1-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Beall in view of U.S. Patent No. 6,285,998, issued to Black et al (hereinafter referred to as "Black"). These grounds of rejection are respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

As to the requirement of MPEP 2143 to show motivation to make the alleged combination of Beall and Black, the Examiner states:

One would have been motivated to modify Beall system as per above for the purpose of organizing steps into row and column so that enhancing dynamically building and utilizing customized services and for reusing the stored query so that user can perform database management function quickly. (Emphasis added)

This is precisely the unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

In the Examiner's own words, motivation exists "for the purpose of organizing steps into row and column so that enhancing dynamically building and utilizing customized services". Not only does this statement not show motivation, it does not even make sense. The Examiner has simply not met her burden of proof with regard to motivation.

The obligation imposed by MPEP 2143 to show "reasonable likelihood of success" is treated even more cavalierly by the Examiner. She just ignores the requirement.

In an attempt to show all of the claim elements within the alleged combination, the Examiner makes clearly erroneous findings of fact. As to claims 1 and 6, the Examiner states:

....data base management system (Fig. 6) having a data base with (sic) executes an ordered sequence of command language script to modify data within said data base (Col. 43, lines 48-46 (sic), and col. 50, lines 9-16).....

As any casual observer would acknowledge, these citations say nothing of "executes an ordered sequence of command language script". Furthermore, as explained above, these citations say nothing about "modifying data". Again, as explained above, the Examiner clearly erroneously equates "modifying structure of data base" with "modifying data of data base".

Similarly, the Examiner attempts to use the same citation to support her finding of:

....wherein said user terminal builds a service specifying one or more database management function (sic) for utilizing a data base management system to modify data from said database (Col. 43, lines 48-46 (sic), and col. 50, lines 9-16)....

Not only do these citations say nothing of "building a service", "specifying one or more database management function[s], or "modify data from said database", they say nothing of a "user terminal". In making this clearly erroneous finding of fact, the Examiner has either ignored the plain meaning of the claim language, the clear teaching of Beall, or both. In accordance with this practice, the Examiner continues to clearly erroneously find all of Applicants' claimed elements.

Therefore, the rejections of claims 1 and 6, and all claims depending therefrom, are respectfully traversed for failure of the Examiner to make any of the showings required to present a *prima facie* case of obviousness.

Claims 2 and 7 depend from claims 1 and 6, respectively, and each further limits the claimed communication network. As explained above, claims 1 and 6 are presumed unobvious for failure of the Examiner to present a *prima facie* case of obviousness. Therefore, these dependent claims are also presume patentably distinct. The rejection of claims 2 and 7 is respectfully traversed.

Claims 3, 9, and 13-14, are dependent claims which limit the software architecture of the "user terminal". In response thereto, the Examiner cites material which say nothing of software architecture as discussed above. Therefore, the rejection of claims 3, 9, and 13-14 is respectfully traversed.

Dependent claims 4, 8, and 12 present further limitations involving "inhibiting presentation of any step which would not be valid". As explained above, the Examiner apparently confuses the functions performed by the claimed machine with functions performed by the human user of Beall. Furthermore, the argument made by the Examiner makes no sense. If the "presentation" were inhibited as alleged by the Examiner, how would the human user know what to cancel with the cited "cancel" button. The rejection of claims 4, 8, and 12 is respectfully traversed.

Dependent claims 5, 10, and 15 are limited by a "commercial data base management system". As explained above, the Examiner's citation mentions a "data base management system" and an allege

"commercial product" which is not a data base management system. As a result, the Examiner has successfully found the words of Applicants' claims without finding the limitations of Applicants' claims. The rejection of claims 5, 10, and 15 are respectfully traversed.

Independent method claim 11 having six steps which are performed by a machine. In response thereto, the Examiner cites portions of Beall and Black which allegedly mention functions performed by a human user. AS a result, the Examiner's findings are clearly erroneous. The rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

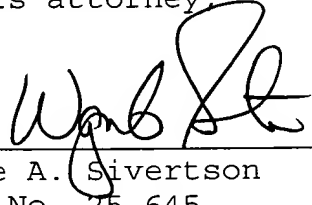
Please charge any deficiencies or credit any overpayment to
Deposit Account No. 14-0620.

Respectfully submitted,

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